

**REMARKS**

This amendment responds to the Office Action mailed on June 26, 2007. The shortened statutory period for response is set to expire on September 26, 2007. Accordingly, applicants respectfully submit that this response is being timely filed.

**Examiner Interview Summary**

Applicants would like to express their appreciation of the courtesy extended by Examiner Vig in contacting applicants' undersigned attorney to discuss suggested claim amendments and also in conducting the Examiner Interview on September 20, 2007 to discuss the above-noted amendments to claims 1 and 14. Claims 1 and 14 are amended above consistent with applicants' understanding from the Examiner Interview that such amendments overcome the prior art rejections of such claims set forth in the most recent Office Action.

Accordingly, claims 1-10, 14-20 and 22-24 remain pending in the present application, and applicants believe these claims are in proper condition for allowance for the reasons set forth below. In summary, the combination of cited prior art fails to teach or suggest 1) a transaction service server determining a preferred communication format for each of the recipient parties for an electronic business transaction document being sent to the recipient parties (as recited in independent claims 1 and 14 as amended above), and 2) an electronic business transaction document containing address information and a preferred communication format indicator for each of the plurality of recipient parties of the business transaction that is automatically retrieved from an electronic address book stored at a client computer (as recited in independent claim 19).

***Claim Rejections - 35 U.S.C. § 103(a)***

Claims 1, 2, 7-10, 14, 18-20 and 23 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over IBM Corporation Product Facsimile Support/400 ("IBM") in view of U.S. Patent No. 6,424,426 issued to Henry ("Henry") and U.S. Patent No. 6,775,711 issued to Akimoto ("Akimoto"). Claims 3-6, 15-17, 22 and 24 were rejected under 35 U.S.C. U.S.C. §



103(a) as being obvious over IBM in view of Henry and Akimoto and further in view of NetGram.com ("NetGram"). Applicants traverse the Examiner's rejections for the following reasons.

Independent Claims 1 and 14 Recite that the Server Computer Determines the Preferred Communication Format of the Recipient Parties

Independent claims 1 and 14 as amended above recite an electronic business transaction service method and software for conducting a business transaction over a computer network and sending a business transaction document in a preferred communication format of a recipient party, wherein the transaction service server computer determines the preferred communication format of each of the plurality of recipient parties of the business transaction.

It is admitted in the Office Action that "IBM in view of Henry does not explicitly teach capability for determining at the transaction service server computer a preferred communication format for each of the plurality of recipient parties of the business transaction." *See paragraph extending between pages 4-5 of the Office Action.* The Office Action cites Akimoto to cure the deficiency of determining a preferred communication format for each of the plurality of recipient parties of the business transaction, where Akimoto is cited as teaching this feature.

However, Akimoto fails to teach or suggest determining at the transaction service server computer a preferred communication format for each of the plurality of recipient parties of the business transaction and then sending the business transaction document in the preferred communication format of a recipient party. The Office Action cites Akimoto's Figure 8 and the associated description as teaching a determination of preferred communication formats. Figure 8, and the description of Figure 8, discuss how various identification characters are used to manipulate the content being transmitted. The processing referred to in Akimoto (which is triggered by various identification characters) is for **content processing**, such as signature processing, encryption processing, JPEG conversion, etc.

Figure 8, and the description of Figure 8, discuss how various identification characters are used to manipulate the content being transmitted. "The mail address analyze section 308



sends the analysis result to the determination section 309 [which] determines whether or not encryption processing is performed in later steps based on the analysis result.” *See* Akimoto, Column 8, Lines 17-21 (describing of Figure 8). “In other words, when the mail address analyze section 308 detects characters “A” to “C” after the identification character “@” the determination section 309 determines that processing according with these characters is executed.” *See* Akimoto, Column 8, Lines 30-35 (describing of Figure 8). Figure 7 is brings further understanding to Akimoto’s identification characters. Figure 7 shows a column of various identification characters and a column of corresponding content processing operations.

“The identification character/processing table is stored in RAM 209. Here, as identification characters, characters A to C are used in addition to “@”, and processing contents are determined in association with these identification characters, respectively. When the identification “A” is added, signature processing is carried out. When the identification “B” is added, encryption processing is carried out. When the identification “C” is added, JPEG conversion is carried out. The JPEG conversion is herein referred to processing for converting the MH file to the JPEG file.” *See* Akimoto, Column 7, Lines 25-35 (describing of Figure 7).

After the Akimoto server executes content processing associated with the identification characters A to C, it then transmits the processed content according to the same transfer protocol, irregardless of the type of the content processing that was performed. For example, see column 9, lines 44-47 of Akimoto which recites that the server only performs processing of the content (i.e., image data) according to the identification characters, but thereafter sends the processed image data in accordance with an e-mail transfer protocol.

It is respectfully submitted that the communication format remains unchanged in Akimoto (e.g., the communication format is e-mail transfer protocol), whereas it is the content that is included in such e-mail transfer protocol communication format that can be altered. To the contrary, independent claims 1 and 14 recite that transaction service server computer determines a preferred communication format for each of the plurality of recipient parties of the business transaction. Independent claims 1 and 14 further recite that it is determined whether the preferred format is either a computer communication format or a non-computer communication



format, where the business transaction document is sent to the recipient in the preferred communication format.

As set forth above, it is admitted in the Office Action that the combination of IBM and Henry fails to teach capability for determining at the transaction service server computer a preferred communication format for each of the plurality of recipient parties of the business transaction. It can further be seen from the above that Akimoto fails to cure this deficiency. As such and as discussed during the Examiner Interview, the combination of IBM, Henry and Akimoto fails to teach or suggest a transaction server determining a preferred communication format for each of the plurality of recipient parties of the business transaction. It is respectfully submitted that the obviousness rejection of independent claims 1 and 14 and their respective dependent claims cannot be maintained in view of the combination of IBM, Henry and Akimoto, and applicants submit that such claims are now in proper condition for allowance.

Independent Claim 19 Recites Automatically Retrieving Address Information and a Preferred Communication Format Indicator from an Electronic Address Book

It is initially noted that independent claim 19 recites an electronic business transaction service method in which the transaction service server computer determines the preferred communication format of each of the plurality of recipient parties of the business transaction. As it set forth above in distinguishing independent claims 1 and 14 over such prior art in view of this feature, it is respectfully submitted that this feature is not taught or suggested by the combination of cited prior art. Thus, applicants believe that independent claim 19 is similarly patentable over the cited prior art for the same reasons set forth above in connection with distinguishing independent claims 1 and 14 over this same prior art.

Further, it respectfully submitted that independent claim 19 is separately patentable of the cited prior art of record, because the cited prior art fails to teach or suggest an electronic business transaction document containing address information and a preferred communication format indicator for each of the plurality of recipient parties of the business transaction that is generated at a client computer by automatically retrieving this information from an electronic address book stored at a client computer.



It is admitted in the Office Action that IBM does not explicitly teach a preferred communication format indicator in a business transaction document indicating a preferred communication format for each of the plurality of recipient parties of the business transaction. *See 2<sup>nd</sup> full paragraph on page 6 of the Office Action.* The Office Action cites Henry as teaching this feature by asserting that Henry teaches that a business document can be sent by a server to a recipient party in their preferred format (fax-to-mail and email-to-fax formats). Applicants traverse this assertion based on the following remarks.

Initially, it is submitted that Henry does not teach a business management software program as disclosed in the present application. Henry discloses technology related to the Internet service MongoNet. Henry allows users to manually fill out a form with email addresses and scan such form into a fax machine for transmission to the email addresses provided in the form. It is the user that fills in the email address on the form, not a computer program on a client computer. The document in Henry to be sent is created by a user and the user handwrites or types the email addresses on a form. See Henry Figure 4. “[T]he user fills in the letterboxes, in normal handwriting, with the final email address(es) it wishes to send to, e.g., “john\_doe@generic.com”. Alternatively, the email address can be printed in a machine-readable format.” Therefore, the form is filled out by a user, and is not created by a business management software program. Applicants submit that Henry does not disclose the limitations that the Examiner has indicated to be taught in Henry.

Namely, there is no disclosure in Henry completing an electronic business transaction documents by retrieving addresses and preferred communication formats from an electronic address book on the client computer, as recited in independent claim 19. Again, it is recognized in the Office Action that IBM fails to explicitly teach preferred communication format indicators. Thus, it is respectfully submitted that combination of IBM and Henry fails to teach or suggest creating an electronic business transaction document containing address information and a preferred communication format indicator for each of the plurality of recipient parties of the business transaction that is generated at a client computer by automatically retrieving this information from an electronic address book stored at a client computer. Still further,

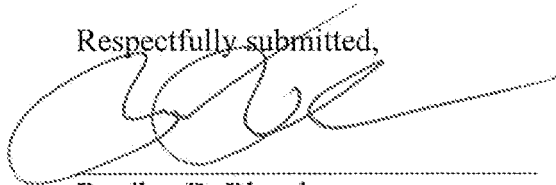


independent claim 19 recites an electronic business transaction service method in which the transaction service server computer determines the preferred communication format of each of the plurality of recipient parties of the business transaction. These features are not taught or suggested by the combination of IBM, Henry and Akimoto. Thus, applicants submit that all of the limitations of independent claim 19 are not taught or suggested by the combination of cited prior art, and it is respectfully submitted that independent claim 19 and its respective dependent claims are patentable over the cited prior art of record. Reconsideration is requested.

### CONCLUSION

In each case, the pending rejections should be reconsidered in view of the amendments and remarks herein. Applicants believe that this case is in good condition for allowance, and a Notice of Allowance is earnestly solicited. If a telephone or further personal conference would be helpful, the Examiner is invited to call the undersigned at 949-732-6539, who will cooperate in any appropriate manner to advance prosecution. The Commissioner is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to **Deposit Account Number 50-2638**. Please also credit any overpayments to said Deposit Account. Please ensure that Attorney Docket Number 070325-040017 is referred to when charging any payments or credits for this case.

Respectfully submitted,



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